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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/581,279	06/09/00	NIKULAINEN	990.1228

IM22/0718

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NEW YORK NY 10036

EXAMINER
HALPERN, M

ART UNIT	PAPER NUMBER
1731	

DATE MAILED: 07/18/01

*6*

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Office Action Summary**

Application No.

09/581,279

Applicant(s)

NIKULAINEN ET AL.

Examiner

Mark Halpern

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### DETAILED ACTION

- 1) Acknowledgement is made of preliminary Amendment received 6/9/2000, Paper No. 5. Applicants offer new claims 7-14 for consideration.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 2) Claims 1-6, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-6; the phrase "and/or" renders the claims indefinite.

Claim 1, line 5; recites the limitation "the outer surface". Claim 2, line 6; recites the limitation "the wire". Claim 3, line 7; recites the limitation "the edges". Claim 5, line 1; recites the limitation "the centers". Claim 5, line 3; recites the limitation "the center radii". There is insufficient antecedent basis for these limitations in the claims.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3) Claims 1, 7-8, are rejected under 35 U.S.C. 102(b) as being anticipated by Aula (US 5,135,614). Aula discloses a suction roll 10 arranged to revolve around axle 18, having end flanges 27a and 27b, a mantle, and openings (with grooves) extending through the mantle into the center of the roll (col. 3, line 4 to col. 5, line 68). Means exist for permitting a flow to travel through the openings in the mantle (Figure 2B).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4) Claims 2-5, 9-14, are rejected under 35 U.S.C. 103(a) as being unpatentable over Aula as applied to claims 1, 7, above, and further in view of Millspaugh (1,805,780).

Claims 2-3, 9-12; Millspaugh discloses numerous designs for a suction roll outer shell used in paper making industry (col. 1, line 5 to col. 2, line 75). In Figures 8, 11, Millspaugh discloses a row of holes and grooves crossing another row of holes and grooves. It would have been obvious to combine the teachings of Millspaugh and Aula, because such a combination would provide more efficient means of providing suction in the roll of the Aula design.

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Claims 4-5, 14; Figure 11 of Millspaugh discloses grooves formed in the outer shell around the holes. It would have been obvious that the grooves be optimized and extend through the center of the holes, if needed, to obtain desired product suction.

5) Claims 6, 13, are rejected under 35 U.S.C. 103(a) as being unpatentable over Aula as applied to claims 1, 7, above, and further in view of Gordon (4,366,025).

Gordon discloses in Figure 5 blind-drilled bores in the outer shell of the roll between holes. It would have been obvious to combine the teachings of Aula and Gordon, because such a combination would provide more efficient means of providing suction in the roll of the Aula design.

### ***Conclusion***

6) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Halpern whose telephone number is 703-305-4522. The examiner can normally be reached on Mon-Thu, (8:30-6:00), and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stanley Silverman can be reached on 703-308-3837. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7718 for regular communications and 703-305-3599 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

MH

Mark Halpern  
Patent Examiner  
Art Unit 1731

July 12, 2001

A handwritten signature in black ink, appearing to read "Peter Chin". The signature is fluid and cursive, with a large initial "P" and a long horizontal stroke extending to the right.

PETER CHIN  
PRIMARY EXAMINER

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1) An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Mr. Paul Higgins on 1/25/2002.

The application has been amended as follows:

Claim 1, lines 6 and 7, and Claim 15, lines 6 and 7: remove word "preferably".

Claim 1, line 3, and Claim 15, line 3: between "surface," and "the mantle" insert  
-, and countersink -

Claim 2, line 2, replace phrase "the first" with - a first -; and in line 3 phrase  
"the second" with - a second -.

2) The following is an examiner's statement of reasons for allowance:

The primary reason for allowance is that the cited prior art does not show a roll for dewatering a web in a paper machine comprising: a mantle having a plurality of bores and recesses through the outer surface of the mantle, so that each bore is connected with each bore adjacent to it in the form of a groove or a recess.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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3) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Halpern whose telephone number is 703-305-4522.

MH

mh

January 25, 2002

A handwritten signature in black ink, appearing to read 'Peter Chin', with a long horizontal stroke extending to the right.

PETER CHIN  
PRIMARY EXAMINER